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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/648,248      | 08/27/2003  | Takahiro Umada       | 1080.1129           | 3679             |

21171 7590 10/31/2005

STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

BERNATZ, KEVIN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1773

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/648,248

Applicant(s)

UMADA ET AL

Examiner

Kevin M. Bernatz

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,7,8,10,12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7,8,10,12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/12/05</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendments to the specification and claims 1, 3, 5, 7, 8, 10, 12 and 14, and cancellation of claims 2, 4, 6, 9, 11 and 13, filed on May 11, 2005 and August 18, 2005, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Double Patenting***

3. Claims 1, 3, 5, 7, 8, 10, 12 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 10 of copending Application No. 10/863,875 (U.S. Patent App. No. 2004/0224119 A1) for the reasons of record as set forth in Paragraph No. 4 of the Office Action mailed on February 11, 2005.

### ***Claim Rejections - 35 USC § 102***

4. Claims 1, 3, 5, 7, 8, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwabuchi et al. (U.S. Patent No. 5,287,334) for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on February 11, 2005.

Regarding the amended language in claims 5 ("the metallic foil is coated directly on the substrate"), 7 ("the metallic foil is formed as one body with the substrate") and

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14, the Examiner the limitation(s) "is coated" and "is formed as one body" are/(is a) process limitation(s) and is/are not further limiting in terms of the structure resulting from the claimed process, except as noted below. Specifically, in a product claim, as long as the prior art product meets the claimed structural limitations, the method by which the product is formed is not germane to the determination of patentability of the product unless an unobvious difference can be shown to result from the claimed process limitations.

In the instant case, the structure resulting from both processes are that the metallic foil is directly disposed on the substrate. The Examiner notes that Iwabuchi et al. teach the resulting structure (*Figure 6, elements 31 and 32*).

5. Claims 1, 3, 5, 7, 8, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakajima (U.S. Patent No. 6,212,137 B1) for the reasons of record as set forth in Paragraph No. 9 of the Office Action mailed on February 11, 2005.

Regarding the amended language in claims 5 ("the metallic foil is coated directly on the substrate"), 7 ("the metallic foil is formed as one body with the substrate") and 14, the Examiner the limitation(s) "is coated" and "is formed as one body" are/(is a) process limitation(s) and is/are not further limiting in terms of the structure resulting from the claimed process, except as noted below. Specifically, in a product claim, as long as the prior art product meets the claimed structural limitations, the method by which the product is formed is not germane to the determination of patentability of the product

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unless an unobvious difference can be shown to result from the claimed process limitations.

In the instant case, the structure resulting from both processes are that the metallic foil is directly disposed on the substrate. The Examiner notes that Nakajima teaches the resulting structure (*Figure 24, elements 15 and 12*).

### ***Claim Rejections - 35 USC § 103***

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima as applied above, and further in view of Shimizu et al. (U.S. Patent App. No. 2002/0012816 A1) for the reasons of record as set forth in Paragraph No. 11 of the Office Action mailed on February 11, 2005.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwabuchi et al. as applied above, and further in view of Shimizu et al. ('816 A1) for the reasons of record as set forth in Paragraph No. 12 of the Office Action mailed on February 11, 2005.

### ***Response to Arguments***

8. **The Double Patenting rejection of claims 1, 3, 5, 7, 8, 10, 12 and 14 in view of copending application 10/863,875**

No arguments were presented.

**9. The rejection of claims 1, 3, 5, 7, 8, 10, 12 and 14 under 35 U.S.C § 102(e) – Yamakage et al.**

The above noted rejection has been withdrawn in view of applicant(s) arguments, which have been found persuasive. Specifically, applicant(s) argue that since the Yamakagi et al. continuation reference was published in Japanese, it does not qualify as an effective filing date.

**10. The rejection of claims 1, 3, 5, 7, 8, 10, 12 and 14 under 35 U.S.C § 102(b) and/or 103(a) – Iwabuchi et al., alone or in view of Shimizu et al.**

All of applicants' arguments are directed to the prior amendment that was directed to a non-elected invention and are not germane to the pending claims.

**11. The rejection of claims 1, 3, 5, 7, 8, 10, 12 and 14 under 35 U.S.C § 102(b) and/or 103(a) – Nakajima, alone or in view of Shimizu et al.**

All of applicants' arguments are directed to the prior amendment that was directed to a non-elected invention and are not germane to the pending claims.

***Conclusion***

**12. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

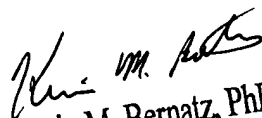
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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (571) 272-1505. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kevin M. Bernatz, PhD  
Primary Examiner

KMB  
October 17, 2005